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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,983	03/10/2004	Jerry V. Mayeux	30310-US-548	5003
5179	7590	07/31/2006	EXAMINER	
PEACOCK MYERS, P.C. 201 THIRD STREET, N.W. SUITE 1340 ALBUQUERQUE, NM 87102			MCCORMICK EWOLDT, SUSAN BETH	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/797,983	Applicant(s) MAYEUX, JERRY V.	
	Examiner S. B. McCormick-Ewoldt	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,20-37 and 83-92 is/are pending in the application.
- 4a) Of the above claim(s) 35,36,85-86 and 88-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,20-34,37,83,84 and 87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment of June 6, 2006 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

Election/Restrictions

Applicant elected Group II and species, nitrogen and calcium, in the reply filed on May 5, 2005.

Claims Pending

Applicant has cancelled claims 1-6, 9-19 and 38-82. Claims 35-36, 85-86 and 88-92 are withdrawn. Claims 7-8, 20-37 and 83-92 are pending. Claims 7-8, 20-34, 37, 83-84 and 87 were examined on the merits.

Objection to Claims

Claim 87 is objected to because of the following informalities: claim 87 is dependent on a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is over the recitation “wherein said oil, being substantially unmixed with said fermentation mixture, is separable from said fermentation mixture for application”. The specification discloses on page 7, lines 1-2, “Blending the volatile fermentation products and by-products into an oil comprises blending the fermentation extract containing the volatile fermentation products and by-products into an oil...”. Thus, Applicant claims said oil being unmixed with said fermentation mixture but Applicant’s specification discloses blending the fermentation products and by-products into an oil which adds new matter. Thus, this limitation may introduce new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation “the inoculum” in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

Claims 7 and 20, 24-29 remain rejected under 35 U.S.C. 102(b) as being anticipated by Tien-Lai (GB 2 191 929 A) for reasons set forth in the prior Office action. Applicant’s arguments filed June 6, 2006 have been fully considered but they are not persuasive.

Tien-Lai (GB 2 191 929 A) disclose using yeast, *Capsicum*, water and a nutrient mixture wherein the nutrient mixture can include sugar, salt or flour which are enough nutrients to ferment yeast (whole document). Calcium is also present in the form of cheese (column 2, line 110). Thus, the ingredients used by Tien-Lai meet the limitations of claim 7 as the composition comprises yeast, *Capsicum*, water and a nutrient mixture and thus anticipates the claimed invention.

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Applicant's arguments concerning the above art rejection have been fully considered but are not deemed to be persuasive. **Applicant argues** that Tien-Lai does not disclose the oil nor oil being layered over the fermentation mixture. This is not found persuasive because the oil is present in the mixture and is mixed which would be layered on the oil (column 1, lines 39-47; column 2, lines 98-99). **Applicant argues** that Tien-Lai is directed to food that must be mixed and baked. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Applicant states the rejected claims 7-8, 20-34, 84 and 87 under 35 U.S.C. 102(a) as being unpatentable over JP-08099813 in view of Flenø *et al.* (US 5,972,642). There was no rejection made in the Office action dated March 9, 2006 concerning this rejection. Therefore, the argument is moot.

Claim Rejections - 35 USC § 103

Claims 7-8, 20-34, 37 and 83-84 and 87 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tien-Lai (GB 2 191 929 A), Flenø *et al.* (US 5,972,642) and Todd (US 6,074,687) for reasons set forth in the previous Office action. Applicant's arguments filed June 9, 2006 have been fully considered but they are not persuasive.

Tien-Lai (GB 2 191 929 A) discloses using capsicum sauce, yeast, sugar, water, chili powder and chili oil which is fermented together to make a bread (whole document). Tien-Lai does not teach using nitrogen and calcium mixture.

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Flenø *et al.* (US 5,972,642) disclose a fermented yeast culture comprising carbohydrate, nitrogen, and micronutrients such as calcium, in a food or feed for animals (column 1, lines 17-20; column 10, lines 44-48; column 11, lines 30-31, 38-45; column 16, lines 49-52).

Applicant's arguments concerning the above art rejection have been fully considered but are not deemed to be persuasive. **Applicant argues** that the combination of Tien-Lai, Flenø and Todd would yield a modified baking recipe, not the present invention. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Applicant's arguments concerning the above art rejection have been fully considered but are not deemed to be persuasive. **Applicant argues** that Tien-Lai does not disclose the oil (page 6, third paragraph of remarks). This is not found persuasive because Tien-Lai discloses the use of oil as disclosed in the prior Office action (column 2, line 47; column 3, lines 2 and 97).

Thus, it was known in the art at the time of the invention that it is routine to add ingredients such as nitrogen and calcium to a medium that is fermented by yeast. A person of ordinary skill in the art would therefore expect that adding nitrogen and calcium to the composition of Tien-Lai would be useful in creating an environment suitable for yeast fermentation. Based on this reasonable expectation, a person of ordinary skill in the art would have been motivated to add calcium and nitrogen to the composition taught by Tien-Lai.

Taken together, Tien-Lai and Flenø teach a composition comprising yeast, capsicum, sugar, water, chili powder, chili oil, nitrogen and calcium. However, the references do not teach using *Capsicum chinensis* in the composition. Todd (US 6,074,687) teaches that *Capsicum chinensis* is commonly used in food and beverages to improve the flavor of the food product (column 1, lines 36-39 and column 6, line 17). Thus, a person of ordinary skill in the art would reasonably expect that *Capsicum chinensis* could be added to the food composition taught by Tien-Lai and Flenø to further improve the flavor of the composition. Based on this reasonable

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expectation of success, a person of ordinary skill in the art would be motivated to modify Tien-Lai and Flenø in such a manner.

It would clearly have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine an effective amount fermented yeast and nutrients and micronutrients, based upon the beneficial teachings provided by the cited references, as discussed above. The adjustment of particular conventional working conditions is deemed merely a matter of judicious selection and routine optimization, which is well within the purview of the skilled artisan.

Claim 7-8, 20-34, 84 and 87 remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP-08099813 A (English translation provided) in view of Flenø *et al.* (US 5,972,642) for reasons set forth in the previous Office action. Applicant's arguments filed June 9, 2006 have been fully considered but they are not persuasive.

JP-08099813 discloses using capsaicin and fermenting wild yeast in a composition to be used as plant growth regulators. JP-08099813 does not disclose using a nutrient medium. However, saccharide or starch can be used as a nutrient medium ([0005]).

Flenø *et al.* (US 5,972,642) disclose a fermented yeast culture comprising carbohydrate, nitrogen, and micronutrients such as calcium, in a food or feed for animals (column 1, lines 17-20; column 10, lines 44-48; column 11, lines 30-31, 38-45; column 16, lines 49-52).

Applicant's arguments concerning the above art rejection have been fully considered but are not deemed to be persuasive. **Applicant argues** that the combination of JP-08099813 and Flenø would yield a modified plant growth regulator, not the present invention. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

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Thus, it was known in the art at the time of the invention that it is routine to add ingredients such as nitrogen and calcium to a medium that is fermented by yeast. A person of ordinary skill in the art would therefore expect that adding nitrogen and calcium to the composition of JP-08099813 would be useful in creating an environment suitable for yeast fermentation. Based on this reasonable expectation, a person of ordinary skill in the art would have been motivated to add calcium and nitrogen to the composition taught by JP-08099813.

Thus, the rejections are deemed proper and are maintained.

Summary

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The official fax number for the group is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme



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PRIMARY EXAMINER